

**Remarks**

The Final Office Action withdrew claims 1-36, 52, 57, 68 and 77 from consideration.

Claims 51, 53, 54, 56, 58-67 and 69-76 were indicated as being allowable if rewritten. Claims 78-82 were allowed. Applicants respectfully thank the Examiner for the indication of allowable subject matter in this case.

Applicants believe that the Office Action contained an error. Claim 51 was not rejected on the art. Further, claim 51 is not a dependent claim as erroneously stated in the Final Office Action. It is an independent claim. The Final Office Action did indicate that claim 51 included allowable subject matter. As a result, it is respectfully submitted that claim 51 and its dependent claims (claims 52-54 and 58-77) should have been indicated as being allowed.

The Final Office Action also upheld an election of species requirement. The election of species requirement was said to be proper because "a claim is only considered generic for restriction/election practice if the claim is generic to all embodiments." Applicants respectfully disagree. The Examiner is respectfully requested to cite authority for this statement (e.g. the statute, rule or MPEP section supporting this position).

MPEP Section 806.04 (d) is entitled, "Definition of a Generic Claim". This section also states, "Once a generic claim is allowable, all of the claims drawn to species in addition to the elected species which require all the limitation of the generic claim will ordinarily be allowable over the prior art in view of the allowability of the generic claim since the additional species will depend thereon or otherwise require all of the limitations thereof." See 37 C.F.R. Section 1.146. There is no reasonable basis to continue to withdraw claims 52, 57, 68 and 77 from consideration.

As set forth in the last response in this case, Applicant respectfully submits that the election of species is clearly erroneous. For example, claim 52 was withdrawn from consideration. However, claim 52 depends from claim 51 which was indicated as

containing allowable subject matter. Claim 51 is also an independent claim. Thus, claim 51 is generic to both the elected species and the species corresponding to claim 52. Since the Final Office Action acknowledges the allowability of a generic claim (claim 51), applicant is entitled to recapture a reasonable number of species. Similarly, claim 77 was withdrawn from consideration but claim 76 was indicated as being allowable. Claim 76 is generic as to both the elected species and any species corresponding to claim 77. Claim 76 was indicated as being allowable. Since the Office Action acknowledged the allowability of a generic claim (claim 76), applicant is entitled to recapture a reasonable number of species. Reconsideration and withdrawal of the election of species requirement is respectfully requested.

Claims 50 and 55 were rejected under 35 U.S.C. Section 103 (a) as being unpatentable over Kochamba et al. (6,251,065) in view of Sterman et al. (5,735,290).

Kochamba discloses an arm 98 and a stabilizer 10.

Sterman discloses clip applier 36 extending through sheath 12, a grasper 32 extending through sheath 10 and thoroscope 34 extending through sheath 12. The thoroscope 34 may also extend through sheath 16. It is respectfully submitted that the thoroscope 34, clip applier 36 and grasper 32 are very different than the arm 98 and stabilizer 10 of Kochamba. Because of the differences in these systems, one of ordinary skill in the art could not reasonably predict that such diverse systems could be combined in order to arrive at the present invention. As a result, it is respectfully submitted that the rejection of claims 50 and 55 should be withdrawn.

With respect to claim 55, the Office action took the position that "the shaft is position in an operative vector in 3-D space and rigidly maintained...". However, Kochamba discloses that the arm 98 is attached to bedpost 104 or sternal retractor 102. Kochamba does not disclose applicant's claimed invention. As a result, claim 55 further comprises allowable subject matter that is not disclosed by any combination of Kochamba et al. and Stermen et al.

AMENDMENT

Serial No. 10/675,815

Filing Date: September 30, 2003

Title: METHODS AND APPARATUS PROVIDING SUCTION-ASSISTED TISSUE  
ENGAGEMENT THROUGH A MINIMALLY INVASIVE INCISION

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Claim 56 is herein converted from a dependent claim to an independent claim by this amendment.

Please charge the fee of \$210.00 for the addition of this independent claim to Deposit Account No. 13-2546. No other fees are believed due for the submission of this amendment after final rejection.

This amendment after final should be entered as it places the case in condition for allowance or reduces the number of issues in this case for appeal.

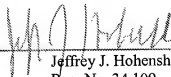
The Examiner's attention is directed to U.S. Pat. No. 7,338,434 issued on March 4, 2008. This patent corresponds to U.S. Patent Application No. 10/643,299 which was identified in the specification as being the parent application of the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 13-2546.

Respectfully submitted,

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By



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